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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,252	07/23/2003	Glen J. Anderson	P1933US00	9293
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GATEWAY, INC.			EXAMINER	
ATTN: Patent Attorney			DUNHAM, JASON B	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,252

Applicant(s)

ANDERSON ET AL.

Examiner

JASON B. DUNHAM

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,9-13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,9-13 and 15-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant added claim 24 in the reply filed June 26, 2008. Claims 1, 3, 5-7, 9-13, and 15-24 are pending.

Claim Objections

Claims 10 and 16 are objected to because of the following informalities: Claims 10 and 16 depend on canceled claims 8 and 14, respectively. Appropriate correction is required. For purposes of examination claims 10 and 16 will be interpreted as depending on claims 7 and 13, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3,5-7,9-13,15-20, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth (US 6,285,987) and Kiely (US 2002/0077960) in view of Katz (US 2003/0130904).

Referring to claim 1. The combination of Roth, Kiely, and Katz discloses a method for providing a real-time marketing opportunity to third parties during a sales transaction between a customer and a seller for purchasing a product of the seller in a

primary order, the real-time marketing opportunity being offered by the seller of the product, the method comprising:

- Establishing a communication connection between the seller and the third parties (Roth: abstract);
- Determining an occurrence of the sales transaction including the primary order for the product of the seller (Kiely: abstract);
- Issuing, by the seller during the occurrence of the sales transaction, an alert over the established connection to the third parties that the sales transaction is in progress (Kiely: abstract, figure 3, and paragraph 10) and a bidding process is open for soliciting bids on the real-time marketing opportunity (Roth: abstract).
- Establishing a time duration for the bidding process associated with the real-time marketing opportunity (Roth: column 7, lines 26 – 33);
- Receiving, by the seller during the occurrence of the sales transaction, one or more bids from one or more of the third parties for the real-time marketing opportunity (Kiely: abstract and paragraph 10 and Roth: abstract). The examiner notes that figure 3 and paragraph 50 of Kiely discloses brokering upsell opportunities during a sales transaction and Roth discloses accepting bids for the marketing opportunity.
- Determining a winning bid for the real-time marketing opportunity included in the bidding process based on the one or more bids raised (Roth: figure 2b).
- Including, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid (Kiely: abstract and

paragraph 10 and Roth: column 12, lines 28 – 40 and column 13, lines 16-24). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth to have included issuing an alert to third parties from the seller during the sale transaction, as taught by Kiely, in order to provide means for direct marketing access to customers (Kiely: paragraphs 4 and 10).

The combination of Roth and Kiely discloses all of the above including providing an upsell offer "at or near" the completion of a transaction (Kiely: abstract) but does not expressly disclose a customer taking advantage of a real-time marketing opportunity as part of the primary order for the product. Katz discloses a method comprising a customer taking advantage of a real-time marketing opportunity as part of the primary order for the product of the seller (Katz: abstract). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth and Kiely to have included an upsell offer as part of the primary offer, as taught by Katz, in order to "incentivise (with an upsell) the potential customer in real time" (Katz: paragraph 33).

- Completing the sales transaction between the seller and the customer for the product (Kiely: abstract).

Referring to claim 3. The combination of Roth, Kiely, and Katz further discloses a method wherein the one or more real-time marketing opportunities include an opportunity to provide an offer to be included in the transaction for the purchase of the product (Kiely: abstract). Roth teaches providing an advertisement but does not expressly disclose providing a peripheral, a promotion, a download, or an offer. It would

have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Roth to have included providing an offer, as taught by Kiely, in order to provide upsell content to customers (Kiely: paragraphs 13 –15).

Referring to claims 5 –6. The combination of Roth, Kiely, and Katz further discloses a method, wherein the step of establishing a communication connection includes:

- Offering general information associated with the one or more real-time marketing opportunities on an Internet site (Roth: abstract) or via a telephone conversation (Kiely: paragraph 24) associated with the seller; and
- Allowing the third parties to establish a communication connection with the seller over the Internet site (Roth: abstract).

Referring to claims 7 and 9-12. Claims 7 and 9-12 are rejected under the same rationale set forth in the rejection of claims 1,3, and 5 - 6. The combination of Roth, Kiely, and Katz discloses apparatus comprising the components disclosed in claims 7 and 9-12.

Referring to claims 13 and 15-18. The combination of Roth, Kiely, and Katz discloses all of the limitations of the article of manufacture claims 13 and 15-18 as discussed above in the rejection of the similar method claims 1,3, and 5 - 6. The combination of Roth, Kiely, and Katz further discloses an article of manufacture permitting a customer to take advantage of marketing offers made during a sales transaction by responding and completing the sales transaction for both the product and offer (Kiely: abstract).

Referring to claim 19. Claim 19 is rejected under the same rationale set forth in the rejection of claim 1. The examiner notes that the marketing opportunity of claim 1 would inherently contain an offer.

Referring to claim 20. The combination of Roth, Kiely, and Katz further discloses a method wherein the real time marketing opportunity includes providing a download, and additionally comprising the step of offering the download to the customer during the occurrence of the sales transaction (Kiely: paragraph 31).

Referring to claim 21. The combination of Roth, Kiely, and Katz discloses a method for providing a marketing opportunity that includes a peripheral along with the sale transaction (Katz: paragraph 104).

Referring to claims 22-24. Claims 22-24 are rejected under the same rationale set forth in the rejection of claims 1 and 13 (see also the abstract of Katz disclosing providing upsell offers in real time and figure 6, block 360 showing offer processing).

Response to Arguments

Applicant's arguments filed June 26, 2008 have been fully considered but they are not persuasive. Applicant argues that the combination of Roth, Kiely, and Katz (specifically Katz) does not disclose taking advantage of a real time marketing opportunity as part of the primary order (as recited in claim 1) for the product by pointing to specific embodiments (figure 7) of Katz. The examiner disagrees as figure 6 clearly shows a customer taking advantage of an upsell (i.e. marketing opportunity) as part (emphasis added) of the primary order. Paragraph 102 expands upon the primary

transaction block 300 (which applicant argues separates the upsell offer from the primary transaction):

[0102] Credit data 332 may be checked in the course of the primary transaction, as well as in the course of generating inputs or processing for the upsell determination. In one aspect, the credit verification may take place in conjunction with a credit verification for the primary transaction. If the primary transaction is a purchase transaction, the credit verification may be obtained for the primary transaction, and then either obtain a specific credit authorization for an amount equal to the expected upsell, or obtain an indication of the amount of available credit remaining. If the amount of available credit remaining is provided, that will provide an indication of the preferably upper bound on the cost of the upsell offer.

Therefore the primary transaction of Katz is not necessarily a purchase transaction (i.e. sales transaction) and the upsell opportunity (blocks 310 and 350) occur before consummation of the primary order fulfillment block 360 including billing (i.e. sales transaction).

Applicant further argues that paragraph 33 of Katz does not teach taking advantage of a real time marketing opportunity. The examiner agrees that paragraph 33 alone does not provide disclosure for taking advantage of marketing opportunities as part of a primary order, however paragraph 33 does provide background and motivation for solving the problem of "incentivising" (sic) customers which Katz later discloses by including upsells in real time. Independent claims 1, 7, and 13 as well their dependents are rejected under this rationale.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625

JBD
10/3/08